

REMARKS/ARGUMENTS

Claim 1-19 are pending in the current application. Claims 1-8 have been allowed. The drawings have been objected to as failing to comply with 37 C.F.R. 1.84(p)(4) as having drawing informalities that have been corrected in a drawing in red attached. The specification additionally has been objected to as having several informalities that have additionally been addressed. Claims 9, 14, and 15 have been objected to as being unclear to the Examiner whether what the inventor is claiming is an apparatus or a method. Finally, claims 9 and 12-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Brandt in view of Wilson. Additionally, claim 10 has been rejected under 35 U.S.C. § 103(a) over Brandt and Wilson as applied to claim 9 and further in view of Middleton. Finally, claim 11 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Brandt and Wilson as applied to claim 9 and further in view of Allemeersch et al. Applicant respectfully traverses all obviousness type rejections.

Claims 9, 14 and 15 have been objected to because it is unclear whether the invention claimed is a method or an apparatus as steps are listed in the body of the claim. The Applicant is unclear as to the basis for the rejection of claims 9 and 14 which incorporate means plus function limitations. Claim 15 has been amended to address any uncertainty. To the extent this does not address the Examiner's objection, Applicant requests that the Examiner specifically identify what portion of the claims are unclear.

In addition, the Examiner has rejected independent claims 9 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Brandt in view of Wilson. An obviousness analysis begins in the

text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guard against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field. See, e.g. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for

piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g. Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

All of the obvious rejections asserted by the Examiner are based on a combination of prior art references, e.g., the wheel mount grain harvester of Brandt with the transporting means of Wilson. To justify this combination the Examiner simply stated "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to include the individual bins of Wilson on the harvester brand in order to provide easy handling for the unskilled worker. (Examiner's Answer, page 5). Rather than point to specific information in

Brandt or Wilson that suggests the combination of the pieces of prior art, the Examiner described the general functions of a harvester and transporting means. Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the prior art references such as the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis. See e.g., Promold and Tool, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996)..

To the contrary, the Examiner's decision is based on a discussion of the ways that multiple prior art references can be combined to read on the claimed invention. (Examiner's Answer, pages 4-9). Yet this reference by reference, limitation by limitation analysis fails to demonstrate how the Brandt grain harvester teaches or suggests its combination with Wilson to yield the claimed invention. For example, the Examiner has not addressed why one skilled in the art would be motivated to combine Brandt with Wilson when the two disclosures teach different purposes. Brandt and Wilson both relate to harvesting crops, but are directed to two different problems. Brandt is directed toward providing a combine that can be operated on hillsides without materially effecting the efficiency or speed of the harvesting operation. Col. 1 lines 59-64. Meanwhile Wilson is directed toward providing an apparatus for removing tobacco leaves from rows of tobacco plants. Col. 3 lines 32-37. There is no suggestion that the teaching of Wilson, directed toward "removing tobacco leaves" be combined with Brandt, as Brandt has no need for removing tobacco leaves. Further, there is no suggestion in Wilson that separate collection bins can be

used for the purpose of continuous harvesting of crop as would be utilized in the Brandt patent.

Additionally the problem the Applicant was confronted with involved the stopping and starting of combines in the field to ensure different varieties of grain are not commingled during the harvesting of different varieties of grain from the same field. Page 1 lines 10-21. The Applicant solves this problem by completely stopping the flow of grain into the combine while the combine is adjusted so that new grain is placed within a different bin. In contrast, in the Brandt device, grain is being redirected so that it will flow efficiently while a combine is on a hillside. See Col. 1 lines 59-63. Hence, the Brandt device teaches away from the complete stoppage of grain and instead teaches continuous grain flow.

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the Applicant took. In re Gurley, 27 F.3d 551, 35 USPQ2d 1130, 1131 (Fed. Cir. 1994). Here, because Brandt teaches the continuous flow of grain within a harvester instead of stopping the flow of grain, one skilled in the art upon reading Brandt, would have been led on a path divergent from that taken by the Applicant.

Additionally, in dependent claims 10 and 11, the Examiner has used disclosures to Middleton and Allemeersch to combine with Wilson and Brandt to arrive at the claimed invention. As before, the Examiner has not provided a motivation to combine

these with Brandt or Wilson. For example, the Examiner has not explained why one skilled in the art would be motivated to combine the Middleton device that solved the problem of providing a reliable harvester for air cure type tobacco with the Wilson or Brandt devices in order to provide a machine that is able to successfully separate grain that is harvested without commingling the grain while continually harvesting the field. Similarly, the Allemeersch device solves the problem of blockages that occur in harvesting machines. (Column 1, lines 55-57). Again, there is no motivation to combine this harvester to arrive at a harvester that successfully separates grains without commingling the grain while harvesting.

Accordingly, because the Examiner has not particularly identified any suggestion, teaching, or motivation to combine the prior art references, in addition to the disclosure of Brandt which teaches away from the proposed combination, the Examiner conclusion of obviousness as a matter law, cannot stand.

Even if there was a suggestion or motivation to combine, the apparatus that would result still would not meet the limitations of claims 9-19. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

More specifically, the proposed combination would not include a "control means on the harvester for selectively interrupting at least one of the grain moving parts as soon the last plant in a first row segment is harvested so that no new harvested grain from a second and next adjacent row segment will be co-mingled with the harvested grain from the first row segment." The Examiner has suggested that the reference to Brandt shows this limitation. However, Brandt does not provide a control means on the harvester for selectively interrupting at least one of the grain moving parts as soon as the last plant in the first row segment is harvested so that no new harvested grain from a second and next adjacent row segment will be co-mingled with the harvested grain from the first row segment. Instead, Brandt provides a control means 40 that regulates the corn fed to one side or the other of a separating unit by a conveyor 18. Thus, the operator has great flexibility to vary the feeding of the grain into the separating unit upon the particular terrain conditions encountered. (Column 4, lines 13-22). This control means allows a continuous flow of grain thus preventing the possibility of grain from a second row of crop from being placed in a separate compartment such that commingling will not occur.

Additionally, the Wilson device does not have a control means on the harvester for selectively interrupting at least one of the grain moving parts as soon as the last plant in a first row segment is harvested so that no new harvested grain from a second and next adjacent row segment will be commingled with the harvested grain from the first row segment. Instead, Wilson provides a vehicle that continually removes leaves from tobacco plants and uses a conveyor assembly to transport the leaves

within the machine. The machine is able to alter the vertical position at which the leaves are removed from the tobacco stalks; however, none of the moving parts of the machine can be selectively interrupted.

The Examiner additionally has used U.S. Patent No. 3,798,884 to Middleton to reject claim 9 as disclosing a set of drag chains that are selectively interrupted by a control means during the harvesting of grain. The Middleton device is a tobacco harvester that continually takes in tobacco into the system during operation. Thus a grain moving part is not interrupted during harvesting to stop the commingling of grain and therefore, each and every limitation is not met even when Middleton is combined with the Wilson and Brandt patents.

Similarly, U.S. Patent No. 4,218,864 to Allemeersch et al. has been used by the Examiner to reject claim 11 as showing a cross auger being the means that is selectively interrupted. Once again, during operation the safety clutch of the header auger is present to ensure that no blocking will occur. (See Column 6, line 64-Column 7, line 2). The safety clutch is present to ensure overloading does not occur and does not involve separating grain and preventing commingling of grain. Consequently, even with the addition of Allemeersch et al., all of the limitations of the claim have not been met. Consequently, each limitation of the combined device is not present and the obvious rejections should be withdrawn.

Independent claim 14 in part states "control means on the harvester for selectively closing the blocking wall as soon as the last plant in a first row segment is harvested so that no new harvested grain from a second and next adjacent row segment will be co-mingled with the harvested grain from the first row

segment." Once again, Brandt does not provide a control means for closing a blocking wall. Instead, Brandt has two doors 20 and 22 that can be moved such that an opening 16 can be blocked off on one side or another, however, cannot be completely blocked to stop grain flow. (Column 4, lines 23-34). Thus, the Brandt control means cannot close the blocking wall and consequently each and every limitation of claim 14 is not met. Claims 10-13 and 15-19 all depend on either claim 9 or claim 14 and therefore, all obviousness rejections must be withdrawn.

CONCLUSION

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



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